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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/560,722 | 04/28/2000 | RONALD G PARKINEN | K35A0604 | 5247 |

26332 7590 05/06/2005

WESTERN DIGITAL CORP.
20511 LAKE FOREST DRIVE
C205 - INTELLECTUAL PROPERTY DEPARTMENT
LAKE FOREST, CA 92630

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| EXAMINER |
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TRAN, THAI Q

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| ART UNIT | PAPER NUMBER |
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2616

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action **Before the Filing of an Appeal Brief**

Application No.

09/560,722

Applicant(s)

PARKINER ET AL.

Examiner

Thai Tran

Art Unit

2616

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED **13 April 2005** FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____
 Claim(s) objected to: _____
 Claim(s) rejected: 1-21
 Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
 13. ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed April 13, 2005 have been fully considered but they are not persuasive.

Claim 21 will be rejected for the same ground as discussed in the Final Office Action.

In re pages 6-7, applicants argue, with respect to the Object to the Drawings, that the originally-filed drawings satisfy the requirements of 37 C.F.R. § 1.83(a) as not showing every feature of the invention specified in the claims because specification explains at page 4, lines 8-12

"By receiving user input 22, the user interface 20 permits the user to indicate to the video recording system 10 which video program segments 34 are selected for recording from the external video data stream 32, **as well as to control various other operations parameter of the video recording system 10, such as playback commands (e.g., pause, instant-replay, etc.),**

specification page 1, lines 12-18 explains that by using utilizing hard disk drive technology, video recording systems, such as personal video recorders, "allow users to pause and resume live television or to observe instant-replay while continuing to record the same incoming video data stream, and conclude that Fig. 2 schematically illustrates an embodiment which "receives at least a portion of a previously recorded video data stream from the at least one external rotating storage drive via the interface while continuing to record the external video data stream for the video program segment" as recited by Claim 1.

In response, the examiner respectfully disagrees. The specification page 4, lines 8-12 and page 1, lines 12-18 discloses that the user interface 20 permits the user to indicate to the video recording system 10 which video program segments 34 are selected for recording from the external video data stream 32, **as well as to control various other operations parameter of the video recording system 10, such as playback commands (e.g., pause, instant-replay, etc.)** and that the personal video recorders allow users to pause and resume live television or to observe instant-replay while continuing to record the same incoming video data stream. The specification clearly discloses the conventional **simultaneously recording and reproducing of the personal video recorders but not** the claimed **"receives at least a portion of a previously recorded video data stream from the at least one external rotating storage drive via the interface while continuing to record the external video data stream for the video program segment"** as recited by Claim 1. Thus, the drawings do not show the claimed limitation **"receives at least a portion of a previously recorded video data stream from the at least one external rotating storage drive via the interface while continuing to record the external video data stream for the video program segment"** as set forth in the Final Office Action.

In re pages 7-8, applicants argue, with respect to the rejection of claims 1-21 under 35 U.S.C. § 112, first paragraph, that, as described above with respect to the objection to the drawings, the specification clearly discloses all the limitations of claims 1-21.

In response, the examiner respectfully disagrees. As discussed above with respect to the objection of the drawings, that the specification page 4, lines 8-12 and page 1, lines 12-18 discloses the conventional **simultaneously recording and reproducing of the personal video recorders but not** the claimed "**receives** at least a portion of a previously recorded video data stream from the at least one external rotating storage drive via the interface **while continuing to record** the external video data stream for the video program segment" as recited by Claim 1. Thus, the claimed limitation ""**receives** at least a portion of a previously recorded video data stream from the at least one external rotating storage drive via the interface **while continuing to record** the external video data stream for the video program segment" as recited by Claims 1 and 15 was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention as the time the application was filed.

In re pages 8-10, applicants argue, with respect to the rejection of claims under 35 U.S.C. § 103(a), that there is no suggestion to combine the teachings of Sato and Ito to produce the system as claimed because obviousness can only be established where there is some teaching, suggestion, or motivation to combine or modify the teachings of the prior art to produce the claimed invention (see *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988)); to support the Examiner's assertion of obviousness, the Examiner must provide clear and particular findings as to the reason one skilled in the art, with no knowledge of the claimed invention, would have selected these components and combined them in the manner claimed (see e.g., *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000); there

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is no teaching or suggestion in the prior art that the video recording system of Sato would benefit in any way from the sequential-access videotape editing system disclosed by Ito; and, that the prior art must provide a suggestion that the combination of teachings would have a reasonable expectation of success.

In response, the examiner respectfully disagrees. The examiner has pointed out in the Final Office Action what each of the prior art references teaches and has indicated how and why these references would have been combined to arrive at the claimed invention. Applicants cannot show non-obviousness by attacking the references individually where, as here, the rejection is based on a combination of references. In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). As stated in the Final Office Action, Sato et al discloses satellite digital broadcasting system in col. 1, lines 13-21 and Ito et al teaches in col. 1, lines 42-48 that **"At broadcasting stations, editing processing for editing a plurality of original video materials recorded on magnetic tapes so as to produce a television program to be on the air is carried out"**. The superior result of editing processing for editing a plurality of original video materials recorded on magnetic tapes so as to produce a television program to be on the air of Ito et al would be needed to motivate the artisan to combine Sato et al and Ito et al. The reasonable expectation of success of the proposed combination is suggested in col. 1, lines 42-48 of Ito et al **"editing processing for editing a plurality of original video materials recorded on magnetic tapes so as to produce a television program to be on the air is carried out"**.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (571) 272-7382. The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTQ



THAI TRAN
PRIMARY EXAMINER